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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,787	02/12/2004	Jean-Pierre Roux	04-14	5413
30030	7590	07/31/2008		
JAMES R. WILLIAMS 3103 WILMINGTON ROAD NEW CASTLE, PA 16105			EXAMINER BLANKENSHIP, GREGORY A	
			ART UNIT	PAPER NUMBER
			3612	
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			07/31/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/777,787	Applicant(s) ROUX ET AL.	
	Examiner GREGORY BLANKENSHIP	Art Unit 3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 7/23/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 10 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10 and 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9, 10, and 12-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 17 are not clearly understood because they claim the "support sheet presents a structure that is discontinuous" when the specification states that the "support sheet extends over the entire length of the top edge of the fender" on lines 15 and 16 of page 2 of the specification. This appears to be a contradiction.

Claim 12 is not clearly understood because it appears to contradict the limitation mentioned above in the rejection of claims 9 and 17.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bien (4,973,102).

Bien discloses a fender support (16) for a motor vehicle comprising a lower portion (28) for fixing on at least one rigid part (38) of the vehicle and an upper portion (26) spaced apart from the lower portion and adapted to support a top edge of a fender

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(14), as shown in Figure 4. The fender (14) has an outside face that is visible on an exterior of the vehicle and an inside face opposite the outside face, as shown in Figure 4. The support (16) holds the top edge of the fender at a distance from the rigid part (38) of the vehicle that is closest to the top edge, as shown in Figure 4. The support has a support sheet comprising support areas (24a,24b,24c,24d) spaced apart from each other and each of which substantially conforms to the inside face of the fender near the top edge, as shown in Figure 4. The support sheet presents a structure that is discontinuous in that the support sheet is broken up by the openings at the support areas (24a,24b,24c,24d) and that the pattern of the openings is not repeated. In reference to claim 12, the support sheet extends over the entire length of the top edge of the fender (14), as shown in Figure 2. In reference to claim 13, the base, the vertical portion of support (16) below support areas (24a,24b,24c,24d) , supports the support areas and the base includes a deformable portion and a breakable portion. All portions of the base are capable of deforming and breaking as broadly claimed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bien (4,973,102).

Bien does not disclose the claimed spacing of adjacent support areas.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to space adjacent support areas of Bien no more than 65 mm apart to provide adequate support areas to attach the fender in a manner that prevents rattling of the fender.

7. Claims 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bien (4,973,102) in view of Kubota (US2003/0173802).

Bien discloses the support, specifically the support sheet, holding the top edge of the fender at a distance from the rigid part of the vehicle that is closest to the top edge, as shown in Figure 4. However, Bien does not disclose the claimed shape of the deformable and breakable portions of the base.

Kubota teaches forming a base of a fender support having a staircase shape, as shown in Figure 6. The staircase shape inherently forms rupture starters as broadly claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was to form the base of Bien with a staircase shape including rupture starters, as taught by Kubota, to improve safety by providing an energy absorbing structure.

8. Claims 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bien (4,973,102) in view of Ozawa (US 2002/0171262).

Bien discloses the support, specifically the support sheet, holding the top edge of the fender at a distance from the rigid part of the vehicle that is closest to the top edge, as shown in Figure 4. However, Bien does not disclose the claimed shape of the deformable and breakable portions of the base.

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Ozawa teaches forming a base of a fender support having a staircase shape, as shown in Figure 3. The staircase shape inherently forms rupture starters as broadly claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was to form the base of Bien with a staircase shape including rupture starters, as taught by Ozawa, to improve safety by providing an energy absorbing structure.

9. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bien (4,973,102) in view of Berger et al. (6,641,191).

Bien discloses fixing clips adapted to secure the rim (18) of the fender to the fender support (16). However, Bien does not disclose a groove that extends the support areas and receives the inwardly-directed rim of the fender.

Berger et al. teach forming a fender support with two vertical members (110,112A) to form a groove between the two vertical members that receives the inwardly-directed rim of a fender (26), as shown in Figure 6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the fender support of Bien with a second vertical member that is parallel and spaced from the first vertical member, as taught by Berger et al., forming a groove to receive the rim of the fender to facilitate attachment of the fender to the fender support.

Response to Arguments

10. Applicant's arguments filed 7/23/2008 have been fully considered but they are not persuasive. The applicant has argued that the apertures (24a,24b,24c,24d) cannot be considered areas of support because they are apertures. The examiner disagrees because these apertures, and the material that surround and define the apertures, are attachment

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points to connect the inside face of the fender to the support sheet. The support sheet supports the inside face of the fender, as claimed, due to the attachment at the areas defined by apertures (24a,24b,24c,24d).

11. The applicant has argued that Bien does not disclose a structure that is discontinuous. The examiner disagrees because the support sheet of Bien is discontinuous because the openings (24a,24b,24c,24d) break up the continuous sheet at discrete locations and the size of the openings are not consistent. Figure 3 clearly shows each opening is of a different size resulting in a structure that does not have a repeating pattern. Further, the applicant's specification states that the "support sheet extends over the entire length of the top edge of the fender" on lines 15 and 16 of page 2 of the specification. It is unclear how something can be discontinuous, as argued by the applicant in the remarks filed 7/23/2008, and extend over the entire length as disclosed.

12. Applicant's arguments filed 7/23/2008 have been fully considered but they are not persuasive. The applicant has argued that Kubota (US 2003/0173802) does not qualify as prior art since it was filed and published after the priority date of the applicant's invention. The examiner would agree if all conditions of 35 U.S.C. 119, but they have not because the applicant has not filed a certified copy of the priority document. Since all conditions have not been met, the applicant's invention has not yet received the benefit of the claimed foreign priority date. Kubota's application was published on 9/18/2003 which is before the applicants US filing date of 2/12/2004. As currently filed, Kubota does constitute prior art for the applicant's invention. When applicant perfects the priority claim, then the rejection based on Kubota will be overcome.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY BLANKENSHIP whose telephone number is (571)272-6656. The examiner can normally be reached on 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 571-272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Blankenship/
Examiner, Art Unit 3612
July 29, 2008